

40. (Amended) An apparatus for preventing the exchange of microorganisms between two persons engaged in the act of French kissing, the apparatus comprising:

a loop frame [sized and shaped] so dimensioned as to outline the mouth, cheeks and chin areas of a person;

a sleeve supported by the frame, the sleeve being made of a thin, flexible sheet material impervious to microorganisms and having a protuberance defining a space sized and shaped to receive the tongue of one of the two persons; and

a handle extending from the frame and adapted for being gripped to support the frame and membrane between the mouth, cheek and chin areas of two persons;

wherein the sleeve prevents exchange of microorganisms between the two persons while the two persons are engaged in the act of French kissing.

#### REMARKS

This is meant to constitute a complete response to the Office Action mailed August 5, 1996, in which claims 23-46 were rejected.

#### Section 112 (Second Paragraph) Rejection of Claims 23, 25, 27, 29, 31, 33, 35, 37, 40, 41, and 43

In the Office Action of August 5, 1996, the Examiner rejected claims 23, 25, 27, 29, 31, 33, 35, 37, 40, 41, and 43 under 35 U.S.C. § 112 (second paragraph), as being indefinite for failing to particularly point out and distinctly claim the subject matter

which Applicant regards as the invention. In support of such a rejection, the Examiner stated:

With respect to claim 23, 29, 31, 37 and 40, the phrase "sized and shaped to outline the mouth, ..." or "sized and shaped to receive the tongue..." does not properly define the metes and bounds of the invention, since the size and shape of these parts of the body can vary significantly in different individuals. Likewise in claims 27, 35, and 43, the term "the frame is positioned to outline the mouth,..." gives a positional limitation which is indefinite for similar reasons as stated previously. With respect to claims 25, 33, and 41, these claims contain limitations which would be given greater weight in a method claim, but not in an apparatus claim.

Applicant has herein amended the claims so as to clarify the metes and bounds of the invention. Initially, it is pointed out that the shape of a human mouth and human tongue cannot be defined with mathematical certainty because, and as the Examiner has acknowledged, these parts of the body can vary significantly from individual to individual. Furthermore, the size of a human mouth will differ between two individuals of different ages. Because of such inherent differences in body part shape, Applicant submits that the claims, as amended, distinctly claim and particularly point out the metes and bounds of the invention as required under 35 U.S.C. § 112, second paragraph.

The purpose of section 112, second paragraph, is to ensure that the scope of the claims is clear so the public is informed of the boundaries of what constitutes infringement of the patent. The test is whether the scope of the claim is clear to a hypothetical person possessing the ordinary level of skill in the pertinent art. A claim may not be rejected solely because of the type of language

used to define the subject matter for which patent protection is sought. In re Swinehart, 439 F.2d 210, 160 USPQ 226 (CCPA 1971).

Applicant respectfully directs the Examiner's attention to Orthokinetics, Inc. v. Safety Travel Chairs, Inc., 806 F.2d 1565, 1 USPQ2d 1081 (Fed. Cir. 1986) (a copy of which is attached hereto). In Orthokinetics, claim language specifying that a certain part of a pediatric wheelchair be "so dimensioned as to be insertable through the space between the door frame of an automobile and one of the seats," was held to be definite. The court held that the phrase "so dimensioned" is as accurate as the subject matter permits and particularly noted that patent law does not require that all possible lengths corresponding to the spaces in hundreds of different automobiles be listed in the patent, let alone that they be listed in the claims. However, the Applicant has herein amended the claims to conform with the "so dimensioned" language of Orthokinetics.

Likewise, as the Examiner has indicated, the mouth and tongue will vary significantly from one individual to another. The term "so dimensioned" is as accurate as the subject matter will allow. The invention relates to a device for protecting the mouth and tongue during intimate contact. Since the mouth and tongue are the specific body parts that are to be protected, it is necessary to claim the invention as being so dimensioned to protect such parts. The patent law does not require that all possible lengths, diameters, depths, and volumes corresponding to the infinite number of sizes and shapes of mouths and tongues be listed in the patent,

let alone that they be listed in the claims: such a task would be unfathomable.

The Applicant, therefore, respectfully submits that claims 23, 25, 27, 29, 31, 33, 35, 37, 40, 41, and 43 are as definite as the subject matter will allow in light of the amendments thereto and that an ordinary person possessing the ordinary level of skill in the art would understand and appreciate the boundaries of what the Applicant claims. Therefore, the Applicant respectfully requests that the rejection of claims 23, 25, 27, 29, 31, 33, 35, 37, 40, 41, and 43 under 35 U.S.C. § 112, second paragraph, be withdrawn and that the claims be passed to issuance.

Rejection of Claims 23, 24, 28, 31, 32, 36, and 39  
under 35 U.S.C. § 102(b) as being anticipated by Laguerre '321

In the Office Action of August 5, 1996, the Examiner rejected claims 23, 24, 28, 31, 32, 36, and 39 under 35 U.S.C. § 102(b) as being anticipated by British Patent No. 1,061,321 to Laguerre. Specifically, the Examiner stated that:

Claims 23, 24, 28, 31, 32, 36, and 39 are rejected under 35 U.S.C. § 102(b) as being anticipated by Laguerre '321. Laguerre shows a frame (2a/3a/4a), a removable or sleeve (5a) made out of vinyl (page 1, line 68), and a handle (1a).

The Applicant respectfully traverses the Examiner's rejection of claims 23, 24, 28, 31, 32, 36, and 39 on the following grounds.

Applicant's invention, as embodied in claims 23, 24, 28, 31, 32, 36, and 39, describes an apparatus for preventing the exchange of microorganisms between two persons engaged in kissing. The apparatus comprises a frame sized and shaped to outline the mouth

of at least one of the two persons kissing, a thin, flexible, and microorganism impervious membrane carried by the frame, and a handle extending from the frame and adapted for being gripped by at least one of the two persons kissing. Therefore, Applicant's invention discloses a "kissing shield" to be used by two individuals practicing some form of protective intimacy.

The Laguerre '321 reference discloses, as stated in the title, "A Marker Adapted for Use in Gardens or Sown Areas to Facilitate the Marking of Trees, Plants or Flowers." Accordingly, Laguerre discloses that the marker comprises vertical support means and a transparent container carried thereby and open at its bottom. The vertical support means is further defined as having an upper end with an integral, elongated, substantially horizontal rigid plate having two upright projections integral with the ends of said plate. The marker further has a stake so that the marker may be driven into the ground in order to anchor the marker near a planting for identification. The transparent container is merely used to protect an identification tag placed on the vertical support means.

A garden marker is not analogous to a device for protecting an individual from microorganisms while kissing. When used properly and as indicated by Laguerre, the marker comprises an identification tag placed on a vertical support, a protective transparent container placed over the identification tag, and the vertical support and protective identification tag is then driven into the ground so as to anchor the marker in a specific location.

The present invention discloses a kissing shield, which when used properly and as indicated by the claims and specification, is placed adjacent the mouth of one individual in order to form a protective barrier from microorganisms when kissing a second individual. The Examiner is suggesting, by using Laguerre as a 102(b) reference, that an individual would have taken the garden marker disclosed by Laguerre and used it as a kissing shield. This would require either removing it from the soil or having both persons who are going to kiss, kneel down on the ground so as to be substantially adjacent the marker in order to kiss. Furthermore, the Laguerre marker is comprised of at least three layers: the first side of the protective cover, the identification tag (which may have more than one layer), and the back side of the protective cover. Moreover, Laguerre is disclosed as having two upwardly spaced members. An individual may be seriously injured and/or blinded if the apparatus of Laguerre would be used as a kissing shield. Due to the inherent aspect of human self-preservation, it would not be obvious to use the apparatus of Laguerre as a kissing shield.

The present invention also comprises a thin flexible membrane impervious to microorganisms which is carried by the frame. There is no intermediary layer such as the identification tag and, in fact, such an intermediary layer as disclosed in Laguerre would render the present invention useless since each subsequent additional layer would result in a loss of sensation between the

individuals kissing and therefore a decreased desire to utilize such a device.

Laguerre plainly discloses a gardening tool - a marker for marking different varieties of garden plants. The present invention discloses a kissing shield - a simple yet effective way to stop the spread of microorganisms between two people engaged in kissing. Laguerre requires at least three layers of material, none of which are required to be impervious to microorganisms while the present invention simply requires a single thin flexible membrane. The Applicant has exercised considerable creative and inventive efforts in arriving at the present invention. A kissing shield was not known in the art prior to Applicant's application and an apparatus for identifying and marking plants in a garden would not anticipate such a kissing device. Furthermore, the Laguerre apparatus could not be put to the use described in the present invention: it has at least three layers which would not allow for the sensation of intimate contact, it is not shaped so as to cover the mouth of a person, and it is anchored in the ground which would require two people to kneel close to the ground before kissing does not prevent the passage of microorganisms between two people kissing. The structural differences between the Laguerre plant identification marker and the present kissing shield, moreover, amply demonstrate that the Laguerre apparatus could not be used in the manner described in the present application and thereby is an inappropriate anticipatory reference.

Applicant, therefore, respectfully requests that the rejection of claims 23, 24, 28, 31, 32, 36, and 39 under 35 U.S.C. § 102(b) as being anticipated by Laguerre, be withdrawn and that such claims be passed to issuance.

Rejection of Claims 25-27, 30, 33-35, and 38 under  
35 U.S.C. § 103 as being unpatentable over Laguerre '321

In the Office Action of August 5, 1996, the Examiner rejected claims 25-27, 30, 33-35, and 38 under 35 U.S.C. § 103 as being unpatentable over Laguerre. Specifically, the Examiner stated that:

Laguerre shows all the functional and structural limitations of the invention as claimed by the applicant including a frame extending "angularly" from the handle since no specific angle is claimed, but does not show the specific frame shape and does not disclose the membrane being impervious to HIV. Although Laguerre does not show the specific frame shape of the applicant's invention it is believed that the functional aspect has been met and a simple change in shape without any adverse or unexpected results is to be considered an obvious choice of design to one of ordinary skill for the benefit of allowing the device to fit more comfortable on the user, especially in view of the lack of any spatial or size limitations as pointed out in paragraph 1 of this office action. Furthermore, it has been held that a change in shape within the bounds of one of ordinary skill is not patentably distinct feature, In re Dailey, 149 USPQ 47 (CCPA 1976). Although Laguerre never mentions any specific characteristics of the membrane, Laguerre has shown the identical material as claimed by the applicant, therefore any corresponding physical properties of the material are considered to be inherent within the prior art.

The Applicant respectfully traverses the Examiner's rejection of claims 25-27, 30, 33-35, and 38 on the following grounds.

As stated above, the present application discloses an apparatus for preventing the exchange of microorganisms between two persons engaged in kissing. The apparatus comprises a frame sized



and shaped to outline the mouth of at least one of the two persons kissing, a thin, flexible, and microorganism impervious membrane carried by the frame, and a handle extending from the frame and adapted for being gripped by at least one of the two persons kissing. Claims 25-27 further defined the apparatus as being heart shaped such that the noses of the individuals fit between the lobes of the heart and that the point extends below the chin of the two people kissing. Overall, Applicant's invention discloses a "kissing shield" to be used by two individuals practicing some form of protective intimacy.

As also previously discussed, Laguerre discloses a marker for use in a garden for identifying different species of plants. The structural elements of Laguerre are different than the structural elements of the present kissing shield, namely that there are several layers of material in Laguerre and that the frame is not shaped so as to outline the mouth, cheeks, and chin of two people kissing and the layers of material are not resistant to the passage of microorganisms. Also, the Laguerre reference is non-analogous art, it would not have been obvious to one of ordinary skill in the art of protective devices to modify the invention of Laguerre, a garden marker, to arise at the unique and nonobvious kissing shield disclosed in the present invention.

As the Examiner has stated, Laguerre does not disclose the specific frame shape of the Applicant's invention. One of ordinary skill in the art would not have changed the frame shape of Laguerre to arrive at the Applicant's frame: one of ordinary skill in the

art would not have taken a **staked garden identification tool** and modified it in such a way to arrive at a shield which prevents the passage of microorganisms therethrough so as to protect two people engaged in kissing. If the Laguerre apparatus was changed in a manner described in the present invention, namely heart shaped, the addition and support of an identifying member protected by the transparent container would be made difficult if not impossible. Laguerre specifically claims two structural members which jut away from the frame at two specific points and thereby support both an identifying member and a protective transparent cover. There is absolutely no basis for one of ordinary skill in the art to take a garden identification tool having spiked supporting members, round the spiked supporting members, remove the identification tag, add a thin flexible membrane resistant to the passage of microorganisms, remove the garden tag from the ground, and placed it between the lips of two people kissing. However, this is exactly what the Examiner has proposed. Laguerre discloses a garden tool significantly different structurally than the kissing shield disclosed in the present invention. In sum, it would not have been obvious to one of ordinary skill in the art to appropriate a staked garden tool, make severe and numerous modifications thereto, and use it as a kissing shield.

Applicant, therefore, respectfully requests that the Examiner's rejection of claims 25-27, 30, 33-35, and 38 under 35 U.S.C. § 103 over Laguerre, be withdrawn and that such claims be passed to issuance.

Rejection of Claims 29, 37, 40-45, and 46  
under 35 U.S.C. § 103 in view of Rubin et al. '456.

In the Office Action of August 5, 1996, the Examiner rejected claims 29, 37, 40-45, and 46 under 35 U.S.C. § 103 as being unpatentable over the Laguerre '321 reference in view of U.S. Patent No. 4,815,456 to Rubin et al. Specifically, the Examiner stated that:

Laguerre shows all the structural and functional limitations of the invention as claimed by the applicant except for the protuberance. Rubin et al. shows the protuberance. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Laguerre to have included a protuberance, since the use of such a protuberance in the face protecting art is well known to aid the prevention of disease transmittal in circumstances such as french kissing.

The Applicant respectfully traverses the Examiner's rejection of claims 29, 37, 40-45, and 46 on the following grounds.

As stated above, the present application discloses an apparatus for preventing the exchange of microorganisms between two persons engaged in kissing. The apparatus comprises a frame sized and shaped to outline the mouth of at least one of the two persons kissing, a thin flexible and microorganism impervious membrane carried by the frame, and a handle extending from the frame and adapted for being gripped by at least one of the two persons kissing. Claims 29, 37, 40-45, and 46 further define the apparatus as having a pocket sized and shaped to receive the tongue of one of the two persons kissing. Overall, Applicant's invention discloses a "kissing shield" to be used by two individuals practicing some form of protective intimacy. And as also previously stated, Laguerre has two spiked protrusions and it does not disclose all

the elements of the present invention and it would not have been obvious to one of ordinary skill in the art to modify the garden identification tool of Laguerre to arrive at a structurally different kissing tool.

The Examiner has recognized the deficiencies of the Laguerre reference and has attempted to supply such deficiencies with isolated, modified elements of the face protector of Rubin. Therefore, for the reasons set forth hereinafter, it is respectfully submitted that the combination of Rubin and Laguerre would not render Applicant's invention as recited in claims 29, 37, 40-45, and 46 obvious over such references to one of ordinary skill in the art. As previously stated, Laguerre does not disclose, teach, or even suggest a kissing shield having as a primary element a thin, flexible membrane which is impervious to the passage of microorganisms. Further, Rubin is directed towards a face protecting art, as acknowledged by the Examiner. There is absolutely no scintilla of evidence which would indicate the motivation of combining Rubin and a severely modified Laguerre in order to arrive at the present invention. It is impermissible to take the present application, dissect its elements, and then use the application as a blue print for picking and choosing among disparate and nonanalogous art references in order to find each element and thereby "obviate" a truly inventive and creative invention, such as the unique kissing shield disclosed in the present application. Although Rubin does disclose a protuberance for receiving a tongue, there is no motivation for combining Rubin

and a severely modified Laguerre to arrive at the presently claimed kissing shield.

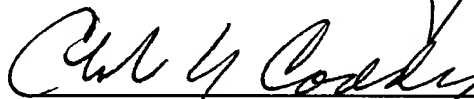
Applicant, therefore, respectfully requests that the Examiner's rejection of claims 29, 37, 40-45, and 46 under 35 U.S.C. § 103, be withdrawn and that such claims be passed to issuance.

Conclusion

In view of the foregoing, it is Applicant's belief that the claims now present in the application are patentable over the art of record and it is respectfully requested that the Examiner withdraw each and every rejection to such claims and pass same to issue.

This is intended to be a complete and full response to the Office Action of August 5, 1996. Should the Examiner have any questions concerning the claims presented herewith or any other matters relating to the application, the Examiner is invited to call Applicant's attorney at his convenience to discuss same.

Respectfully submitted,



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